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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/089,756	04/03/2002	Ajit Kumar Zacharias	AZSI-P-010	2901

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EXAMINER

LEE, SEUNG H

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 11/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/089,756

Applicant(s)

ZACHARIAS, AJIT KUMAR

Examiner

Seung H Lee

Art Unit

2876

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 28-53 is/are pending in the application.
- 4a) Of the above claim(s) 31,33,34,37-43 and 53 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 28-30,32,35,36 and 44-52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

1. Receipt is acknowledged of the response filed on 29 July 2003 and 06 August 2003, which has been entered in the file.

Drawings

2. The drawings were received on 29 July 2003. These drawings are accepted.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 28-30 and 50-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rose et al (US 5,770,843, of record)(hereinafter referred to as 'Rose').

Rose teaches a card processing system or automatic teller machine (ATM) to receive an index number or personal identification number (PIN), a card reader (24) coupled to the ATM to read a data identification number or account number from a single card, identifying the account using a PIN from users to identify which account should be activated among several subset of a domains (e.g., Adams's account, Bauer's account, Wilcox's account) (see Fig. 4-6; col. 1, line 64- col. 3, line 26).

Although, Rose teaches that the matching PIN activates the card processing system to access the data within the domain, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Rose's system to deactivates/disable the card device if the PIN supplied by users matched within the domain in order to prevent unauthorized accessing of the information stored on the card and/or the remote system, and therefore an obvious expedient.

5. Claims 32, 35, 36, and 45-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rose further in view of Peirce (US 4,485,300, of record).

The teachings of Rose have been discussed above.

In addition to the teachings of Rose as discussed above, Rose also teaches to determine the identification number is needed for accessing account (see Fig. 6).

However, Rose teaches the card processing system, Rose fails to teach or fairly suggests that the card processing system comprise a card translator subsystem.

Peirce teaches the card processing system includes a merchant member bank (32) and a data control center serves (20) as the card translator subsystem to forwarding the data from the merchant (30) or card processor system to the issuer system (12), and disabling of the card access or authorization if the account number is found in the second storage (40), sending a acknowledgement signals, recording of all transactions (see figure; col. 4, line 50- col. 8, line 50).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the notoriously old and well known the bank

transaction system as taught by Peirce to the teachings of Rose in order to provide an improved and an enhanced processing system by forwarding the transaction request to appropriate issuer system as needed. Moreover, such modification would provide an additional security means by supplying the black list (i.e., a list of account in which reported as stolen or lost) within the local system in case of connection failure.

Although, Rose as modified by Peirce fail to particularly teach or fairly suggest that the client subsystem is portable or mobile, and disable/re-enable access to account number, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the client subsystem as mobile terminal or portable terminal, since it has been held that making an old device portable or movable without producing any new and unexpected result involves only routine skill in the art. *In re, Lindberg*, 93 USPQ 23 (CCPA 1952). Furthermore, it would have been an obvious to one of ordinary skill in the art at the time the invention was made to disable to accessing of the first account information in which is not accessed while the second or third account within the same card is being accessed, then re-enabling of the first account for being accessing if the appropriate information was supplied by the customer(s), an therefore an obvious expedient.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA

1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claim 44 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,494,367. Although the conflicting claims are not identical, they are not patentably distinct from each other because in claims 31, 37-44, and 53 of the instant application, Applicant claim a system for secure processing of multi-application card device comprising a client subsystem such as a card reader for reading data, a card issuer subsystem, a card translator subsystem comprising a database having a record, and receiving an account number request including an identification number and an index number, retrieving a record from database according to the identification number, verifying the index number, disabling access to the account information if the index number is within a second subset of index number, and re-enabling access to the account information if the index number is within the third subset of index number.

Claims 1 and 2 of the US Patent NO. 6,494,367 show and discloses a system allowing a single card device to be utilized in accessing a plurality of applications, the system comprising a card processing system, a card reader communicatively coupleable to the card processing system, the card reader being operative to read a data identification number from the single card device and to receive an index number

selected by a user of the card device through a data interface, the processing system, in response to receiving the data identification number and said index number from the card reader, being operative to identify an account number associated with the data identification number and said index number when the index number is within a first subset of index numbers chosen by an authorized holder of the card device from a domain of potential index numbers, disabling the card device from further use when the index number is within a second subset of index numbers chosen by the authorized holder of the card device from the domain of potential index numbers, and re-enabling a disabled card device when the index number is within a third subset of index numbers chosen by the authorized holder from the domain of potential index numbers.

Therefore, as discussed above, the scope of claims 31, 37-44, and 53 of the present application and claims 1 and 2 of US Patent No. 6,494,367 are practically identical.

Response to Arguments

Applicant's arguments filed 29 July 2003 and 06 August 2003 have been fully considered but they are not persuasive.

In response to applicant's argument that "*a first subset of index numbers identifies a single account*" (see page 2, line 33+), Rose reference also teaches the PIN number in which is assigned to each and every account (e.g., Adams' account, Bauer's account, Wilcox's account).

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a lock code, an unlock code, the use of a card translator subsystem to translate (without additional input) an identification number and index number to a single account number) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to the applicant's argument that *"Rose uses PINs which are found to be the same for all accounts of s card owners..."* (see page 3, line 42+), the Examiner respectfully disagrees with the applicant wherein Rose clearly teach that the a plurality of account numbers in which the account having its own PIN (see claim 1). Therefore, given its broadest reasonable interpretation of this instant claimed invention, the combination of Rose meets the claimed limitation.

In response to the applicant's argument that *"In the Rose invention, it is not possible to identify an account number using the MAC identification number and the PIN because multiple account have the same PIN."* (see page 4, line 44+), the Examiner respectfully disagrees with the applicant wherein Rose clearly teach that a user is providing a code and PIN number in order to access account (see claim 1).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure;

Taylor [US 5,578,808] discloses a multi-application data card.


Any inquiry concerning this communication or earlier communication from the examiner should be directed to Seung H. Lee whose telephone number is (703) 308-5894. The examiner can normally be reached on Monday to Friday from 7:30 AM to 4:00 PM.

If attempt to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (703) 305-3503. The fax-phone number for this group is (703) 308-5841 or (703) 308-7722.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [michael.lee@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.


Seung H. Lee
Art Unit 2876
November 01, 2003


MICHAEL G. LEE
SUPERVISORY PATENT EXAMINER
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